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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,335	09/25/2003	Michael Eckert	112740-880	9668
29177	7590	12/01/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			LASHLEY, LAUREL L	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/672,335

Applicant(s)

ECKERT ET AL.

Examiner

Laurel Lashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 04/12/04 was filed before the mailing date of the first Office action on the merits on 11/22/2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1 – 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Menzel et al. in US Patent No. 7079656 (hereinafter US '656).

As for claim 1 and similar claim 10, US '656 discloses:

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A method for secure establishment of a direct communication connection between at least a first communication terminal device and a second communication terminal device, the method comprising:

- providing that the direct communication connection operate according to a first communication standard;

- providing a switched communication connection operating according to a radio communication standard between the first communication terminal device and the second communication terminal device; and

- effecting an exchange of keys between the first and second communication terminal devices for encrypting data transferred over the direct communication connection, wherein the exchange of keys is at least partially performed via the switched communication connection.

(see Abstract; column 1, line 60 – column 2, line 1 – 19)

For claim 2 and similar claim 11, US '656 discloses:

A method for secure establishment of a direct communication connection between at least a first communication terminal device and a second communication terminal device as claimed wherein the radio communication standard is a UMTS standard. (see column 4, lines 43 – 48)

For claim 3 and similar claim 12, US '656 teaches:

A method for secure establishment of a direct communication connection between at least a first communication terminal device and a second communication terminal device as claimed, further comprising transmitting a first message, as a request, from the second communication terminal device to the first communication terminal device, prior to the exchange of keys, wherein the first message contains address information uniquely authenticating the second communication terminal device in a network configured according to the radio communication standard. (see column 3, lines 22 – 29)

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For claim 4 and similar claim 13, US '656 teaches:

4. A method for secure establishment of a direct communication connection between at least a first communication terminal device and a second communication terminal device as claimed, further comprising: transmitting a second message from the first communication terminal device to the second communication terminal device via the switched communication connection, wherein the second message contains a first key; and transmitting a third message from the second communication terminal device to the first communication terminal device via one of the direct communication connection and the switched communication connection, wherein the third message contains a second key. (see column 2, lines 1 – 18 and 45 – 64; column 3, lines 5 – 7)

For claim 5 and similar claim 14, US '656 discloses:

A method for secure establishment of a direct communication connection between at least a first communication terminal device and a second communication terminal device as claimed, the method further comprising:

transmitting a randomly generated bit sequence, as part of the second message, from the first communication device to the second communication device via the switched communication connection;

encrypting the bit sequence with the first key in the second communication terminal device;

transmitting the encrypted bit sequence, as part of the third message, from the second communication terminal device to the first communication terminal device via one of the direct communication connection and the switched communication connection;

comparing the bit sequence of the second message with the encrypted bit sequence of the third message in the first communication terminal device; and

effecting a data exchange between the first communication terminal device and the second communication terminal device, if the bit sequence of the second message matches the encrypted bit sequence of the third message, via the direct communication connection, wherein data originating from the first communication terminal device is encrypted with the second key and data originating from the second communication device is encrypted with the first key. (see column 1, line 64 – column 2, line 64)

For claims 6 -7 and 15 -16, US '656 teaches:

A method for secure establishment of a direct communication connection between at least a first communication terminal device and a second communication terminal device as claimed, wherein the transmission of at least one of the second message and the third message operates according to a standard for short messages transmitted via radio. (see Figure 2; column 2, lines 25 – 30)

For claim 8 – 9 and 17 – 18, US '656 discloses:

A method for secure establishment of a direct communication connection between at least a first communication terminal device and a second communication terminal device as claimed, wherein the transmission of at least one of the second message and the third message operates according to a standard for transmitting packet data. (see column 7, lines 15 – 22; Figure 3)

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Freitag et al. in US Patent No. 6804506 discloses radio communications system for controlling security-related functions.

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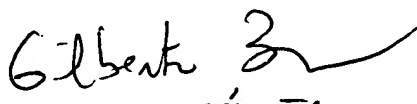
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel Lashley whose telephone number is 571-272-0693. The examiner can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laurel Lashley  
Examiner  
Art Unit 2132

 22 November 2006  
LLL

  
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